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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,450	11/25/2003	John J. Breen	16356.827 (DC-05388)	7118
27683 7590 02/09/2009 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
EXAMINER				
O'NEILL, KARIE AMBER				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
02/09/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/721,450

**Applicant(s)**

BREEN ET AL.

**Examiner**

Karie O'Neill

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-54 is/are pending in the application.
- 4a) Of the above claim(s) 29-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Applicant's amendment filed on December 5, 2008, was received. Claim 51 has been amended. Claims 29-50 have been withdrawn from consideration as being drawn to non-elected claims. Therefore, Claims 51-54 are pending in this office action.
2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action issued on September 29, 2008.

### ***Claim Rejections - 35 USC § 102***

3. The rejection of Claims 51-54 under 35 U.S.C. 102(e) as being anticipated by Perkins et al. (US 2004/0157116 A1) have been overcome based on the amendment to the claim.
4. Claims 51 and 53-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al. (US 16,191,941 B1).

With regard to Claim 51, Ito et al. discloses in Figures 1-3, a battery powered device (100), comprising: a chassis, or body (2); a battery bay, or back end (2F) of the body; and a battery assembly, called a battery pack (200), the battery assembly (200) comprising a plurality of battery subassemblies (210, 220) that are operable to be mechanically mated and electrically coupled together to form the battery assembly (200) (column 6 lines 47-49), the plurality of battery subassemblies (210, 220) comprising: a

first subassembly, called a short battery portion (210), including a first plurality of batteries and having a mating surface member, called hinge recesses (211), including a first pattern for mating engagement with a second subassembly, called a long battery portion (220), including a second plurality of batteries and having a mating surface member, called hinge fitted protrusions (221), including a second pattern, which is an inverse pattern to engage the first pattern, the patterns, or hinges (211,221) supporting battery cells within the subassemblies (210, 220) and also resisting relative movement between the first and second subassemblies (210,220) when the mating surfaces are engaged to form the battery assembly (column 6 lines 66-67 and column 7 lines 1-10); and the first subassembly (210) and the second subassembly (220) coupled together by a hinge (240) about which the first and second subassemblies (210,220) rotate and engage their respectively inverse patterns when mated to form the battery assembly. Ito et al. discloses in column 6 lines 66-67 and column 7 lines 1-10, "the long battery portion (220) is rotatably supported with respect to the short battery portion (210) through hinge mechanisms (240). More specifically, the long battery portion (220) is rotatably joined by fitting protrusions (221) of the long battery portion (220) to corresponding recesses (211) in the short battery portion (210) and rotatably linking the protrusions (221) to their corresponding recesses (211.)."

Claim 51 is drawn to a product, i.e. a battery powered device. The phrase "being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt by the user to avoid increased shipping fees" is considered functional language and imparts intended use to the product. Therefore, while the intended use

language of the claim has been considered with regard to structure of the product, it is not given patentable weight because it is directed to a process and not directed to the structural features of the product. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2111. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. See MPEP 2113.

With regard to Claims 53-54, Ito et al. discloses in Figures 4, 5 and 23, the battery powered device (100) being a portable computer including a central processing unit (35) located within the device housing body (2) (column 10 lines 8-11).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US 6,191,941 B1), as applied to Claims 51 and 53-54 above, and in further view of Perkins et al. (US 2004/0157116 A1).

Ito et al. discloses the battery powered device in paragraph 4 above, including the use of rechargeable or secondary battery cells, for example, lithium ion secondary batteries (column 7 lines 10-11). Ito et al. does not disclose wherein the first battery subassembly exhibits a first cell chemistry and the second battery subassembly exhibits a second cell chemistry, wherein the first cell chemistry is different from the second cell chemistry.

Perkins et al. discloses wherein a first battery subassembly (18a) exhibits a first cell chemistry and a second battery subassembly (18c) exhibits a second cell chemistry, wherein the first cell chemistry is different from the second cell chemistry, the different cell chemistries being nickel-cadmium and/or nickel-metal hydride as well as other types of rechargeable batteries known in the art (paragraph 0031). These other types of batteries may be used to replace or in addition to nickel-cadmium and/or nickel metal hydride batteries (paragraph 0031). Therefore, based on the teachings of the prior art, it would have been obvious to one of ordinary skill in the art at the time of the invention to use battery sub-assemblies having different cell chemistries in the battery powered device of Ito et al., because Perkins et al. teaches that any suitable rechargeable battery power sources, such as nickel-cadmium, nickel metal hydride or others known in the art such as lithium ion batteries, will work in combination with one another to provide more power, while being thin (paragraph 0062).

***Response to Arguments***

7. Applicant's arguments filed December 5, 2008, have been fully considered but they are not persuasive.

*Applicants submit that "the references do not disclose the first subassembly and the second subassembly coupled together by a hinge about which the first and second subassemblies rotate and engage their respectively inverse patterns when mated to form the battery assembly".*

The rejection under 35 U.S.C. 102(e) as being anticipated by Perkins et al. (US 2004/0157116 A1) have been overcome based on the amendment to the claim. However, Ito et al. teaches the claim limitations. The rejection is noted in paragraph 4. Ito et al. specifically discloses, "the long battery portion (220) is rotatably joined by fitting protrusions (221) of the long battery portion (220) to corresponding recesses (211) in the short battery portion (210) and rotatably linking the protrusions (221) to their corresponding recesses (211)".

*Applicants also submit that "the references do not teach hinged first and second subassemblies which rotate to "nest together and electrically couple which resisting relative movement""*

This argument is to a limitation that is not found in the claims. Limitations appearing in the specification but not recited in the claim are not read into the claim. See MPEP 2106.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karie O'Neill whose telephone number is (571)272-8614. The examiner can normally be reached on Monday through Friday from 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Ruthkosky/  
Primary Examiner, Art Unit 1795

Karie O'Neill  
Examiner  
Art Unit 1795

KAO